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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,460	01/15/2002	Olaf Vancura	2001/7	6092

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EXAMINER
MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
3713	8

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/050,460	VANCURA, OLAF	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 January 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4 and 5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because the length exceeds the allowed maximum length. Correction is required. See MPEP § 608.01(b).

Information Disclosure Statement

The information disclosure statement filed 14 August 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Further, the listing of references in the specification (Atronic's "Break the Spell", IGT's "Munsters", Silicon Gaming's line of slots, Mikohn Gaming Yahtzee and Battleship) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method steps of claims 1-9 should be illustrated in a flowchart manner depicting the logical flow of the steps. Further, the

apparatus of claim 10, including all the limitations and function of the limitations listed must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite in that it does not positively link the steps of the method into a logical ordered sequence. Further, the usage of symbol in step b) does not properly define if it is a symbol from the matrix or just any symbol. Further, there is not antecedent basis for position in step c). The usage of the word and/or in step d) also makes the claim indefinite as it does not properly define that which is included in the claim nor exclude that which is not.

Claim 2 is indefinite in that it does not positively link the steps of the method into a logical ordered sequence. Further, the usage of symbols in step d) does not properly define if it is a symbol from the matrix or just any symbol. Further, there is not antecedent basis for positions in step e). The usage of the word and/or in step f) also makes the claim indefinite as it does not properly define that which is included in the claim nor exclude that which is not.

Claim 3 and those dependent therefrom are indefinite in that it does not positively link the steps of the method into a logical ordered sequence. Further, the usage of symbol in step b) does not properly define if it is a symbol from the matrix or just any symbol. Further, there is not antecedent basis for position in step c). The usage of the word and/or in step d) also makes the claim indefinite as it does not properly define that which is included in the claim nor exclude that which is not.

Claim 4 is indefinite in that it does not further limit the parent claim and therefore as written, it appears to replace the parent claim and would not be understood by one of ordinary skill in the art.

Claim 5 is indefinite in that it would not be clear to one of ordinary skill in the art what is meant by the phrase "the step of awarding having..."

Claim 6 is indefinite in that it would not be clear to one of ordinary skill in the art what is meant by the phrase "the step of having the enhanced..."

Claim 7 is indefinite in that one of ordinary skill in the art would not understand how the step is positively linked to the rest of the method claim, as it is not definitely associated with the parent claim.

Claim 8 is indefinite in the one of ordinary skill in the art would not understand how the step is positively linked to the rest of the method claim, as it is not definitly associated with the parent claim in that the step does not appear to have an antecedent basis in the limitation. Further, the usage of and/or in line 3 also makes the claim indefinite as it does not properly define that which is included in the claim nor exclude that which is not.

Claim 10 is indefinite in that the elements of the apparatus are not positively linked in that one of ordinary skill in the art would understand the interrelation. Further, the usage of and/or in step a) also makes the claim indefinite as it does not properly define that which is included in the claim nor exclude that which is not. The usage of symbols in step c) does not properly define if it is a symbol from the matrix or just any symbol.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 8-10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Singer et al. (US Patent No. 6,604,740).

Singer et al. discloses a method for playing a slot machine. The player is able to access the rules of play and pay table (FIG 6A, Column 15, line 30) and the player must make a wager in order to begin play (Column 8, lines 7-10). To begin play, the player is presented with a display that presents the player with a symbol matrix (Column 8, lines 4-6). The matrix inherently includes random symbols, as it is the result of the last play that randomly spun the reels (Column 12, lines 60-65). The player may incorporate strategy by being able to select one symbol as a wild symbol (Column 10, lines 15-20) and positions associated with that symbol are

converted to wild (Column 10, lines 57-61, FIG 9B) and the player is awarded based upon a paytable (Column 10, lines 57-61).

Regarding claim 4, Singer et al. disclose that all positions associated with the symbol are wild (FIG 9B).

Regarding claim 5, Singer et al. disclose that a wild symbol that is used in a winning combination may increase the value, such as doubling it (Column 11, lines 45-47) thus the step of awarding includes a multiplier.

Regarding claim 8, the player is able to apply strategy in that they can choose, based on the pay table information, whether to strategize in the manner of going after the symbol of less value in the pay table which is more likely to occur, or to apply a strategy wherein they will choose a symbol with a greater value, thus having a greater award, but at the risk of it not occurring as often.

Regarding claim 9, the player can qualify for selecting a symbol based upon an at random criteria (Column 4, lines 50-54).

Regarding claim 10, the apparatus claimed would be inherent to the method disclosed by Singer et al. Singer et al. includes a display (FIG 4, reference 418). The device axiomatically includes a processor that would be in charge of randomly displaying the symbols. The player is provided with an input to choose the symbols (FIG 4, references 420, 422, and 424). The processor would also include the capability to change the symbols and awarding the player.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singer et al. (US Patent No. 6,604,740).

What Singer et al. disclose has been discussed above and is incorporated herein.

Singer et al. disclose that a wild symbol that is used in a winning combination may increase the value, such as doubling it (Column 11, lines 45-47) thus the step of awarding includes a multiplier.

Singer et al. do not disclose the manner in which the multiplier is determined, only gives an example of such a multiplier. It would therefore be obvious to one of ordinary skill in the art to incorporate other such multipliers for use on the wild symbol. One of ordinary skill in the art would thus be motivated to apply a random multiplier as a design choice as such a feature is

notoriously well known in the art and would be obvious to assign any such value as long as the casino is still keeping the house advantage.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singer et al. (US Patent No. 6,604,740) in view of Bennett (US Patent No. 6,089,977).

What Singer et al. disclose has been discussed above and is incorporated herein.

Singer et al. disclose symbols displayed in columns and rows and that when as symbol is chosen, all the other symbols with the same value are also converted. Singer et al. do not disclose that all the symbols in a row or column change based on the wild card.

Bennett discloses of a Wild card that is received in the same manner as that of the Singer et al. system. When received, the wild card has the ability to systematically change the symbols of adjacent locations into the wild symbol.

It would be obvious to one of ordinary skill in the art to change symbols adjacent to the wild symbol, as disclosed by Bennett. Incorporating just rows and columns would be an obvious design choice over the disclosure of Bennett. Further, one of ordinary skill in the art would be motivated to change symbols in only columns or rows based on the disclosure of Bennett in order to provide the player with a greater chance of winning, as it is well known in the art that columns and rows are known to be paylines and thus by allowing them to be change, as suggested by Bennett, the player would feel more excitement and anticipation towards the game as they would feel more likely to win. Thus, they would be further inclined to play the game in anticipation of a wild symbol that, as per the teaching of Bennett, would change those symbols adjacent to it, thus resulting in a great chance of winning.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams (US Patent No. 5,431,408).

Adams discloses a method and apparatus for playing a gaming machine that includes displaying a matrix of symbols (FIG 2, reference 30). The player can then select a symbol (Column 4, lines 5-10) and effectively replace it with a wild card, previously reserved by the player. The award is then based on the paytable for the hand (Column 4, lines 5-10).

The game axiomatically includes presenting the players with the rules and pay table as is notoriously well known in the art. Further, the player must make a wager to begin play (Column 3, lines 40-50). The selection the player uses to replace the symbol after play is based upon the rules of the game as the player would be known to be going for the highest hand possible (Column 4, lines 5-10) thus allowing the player to strategically play the game.

Adams discloses converting all the symbols in the column to the specially selected wild symbol as well as permitting the player to apply strategy based on information available on the rules and paytable.

Regarding claim 4, Applicant admits the limitation is prior art and thus well known (page 2, lines 7-14). Therefore, in application to Adams, it would be obvious to one of ordinary skill in the art to allow for the selected symbols of the same value to both be replaced by the wild card.

Regarding claims 5-6, the application of multipliers to payout tables is notoriously well known in the art and thus obvious.

Regarding claim 9, the player is afforded the usage of the wild card upon the random situation that its usage would be advantageous to the player (Abstract).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,517,433: Gaming device that includes a traveling wild symbol that can be changed after the spin of the reels.

US Patent No. 6,517432: Gaming device that includes a traveling wild symbol that will change the value of the reels after the spin.

US Patent No. 5,997,401: Gaming machine that gives the player the ability to substitute symbols in after the completion of a spin to achieve a winning combination.

US Patent No. 6,270,412: Gaming machine that gives the player the ability to substitute symbols in after the completion of a spin to achieve a winning combination.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm

cmm

Teresa Walberg
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